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REMARKS

Claims 1 and 4 stand rejected under 35 U.S.C. §102(b) over Sterett et al. ('844). However, claim 1 has been amended to better define the process used for deposition, namely, heating a localized region of a substrate with a laser to create a melt pool of heating metal powder into that pool to achieve the build-up of material in a deposition zone. This clearly distinguishes over Sterett et al., which is limited to the use of droplets.

Claims 1 and 6 stand rejected under 35 U.S.C. §103(a) over Beaman ('405) in view of Sterett. The amendment to claim 1 further distinguishes over this combination, in that, according to Applicant's invention, a deposition head including a laser and surrounding metal powder feed is moved from one deposition zone to another to achieve the build-up of material, whereas the apparatus of Beaman et al. simply scrapes powder from one location to another which is then sintered to form an article. As such, the processes are entirely different.

While it is believed that claims 2-5 and 7-10 are allowable because the claims from which they depend are allowable, Applicant traverses the rejection over Beaman in view of Sterett, and further in view of Murnick ('825). The Examiner's arguments regarding proposed combinations are not supported by any actual evidence. For example, the Examiner states that it would have been obvious to modify Beaman "so that an accurately built metal object could be formed." However, there is no teaching from the prior art that greater accuracy would be provided through such a modification. The Examiner's argument that it would have been obvious to modify Beaman and Sterett in view of Murnick "to use multiple beams or defocus the beam to reduce stress," simply uses Applicant's own claim language without any evidence in support of the proposed combination. The same holds true with the Examiner's argument that it would have been obvious to modify Beaman and Sterett in view of Murnick to use the same laser to deposit both the material and to reduce distress the reduce the required number of lasers again simply uses Applicant's own claim language against the Applicant.

At the bottom of page 6 of the Office Action, Applicant disagrees that "metal" should not be given any patentable weight because it occurs only in the preamble. This is certainly not the case. Apart from the fact that Applicant has amended claim 1, previously the preamble included a definition of DMD, namely, direct metal deposition, and then, by bringing the term DMD down into the body of

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the claim, it should be clear that metal is the material being deposited.

Claims 1-5 stand rejected under 35 U.S.C. §102(b) over Murnick. Given that Murnick is limited to the surface glazing of ceramic articles, anticipation has not been established. Claims 6-10 stand rejected under 35 U.S.C. §103(a) over Murnick. The Examiner argues that "It would have been obvious to one of ordinary skill in the art to modify Murnick to use powdered material to repair an object and give the proper appearance in view of the teaching of Murnick." This is not persuasive, since there is no teaching or suggestion *from the prior art* to justify the combination, nor is the problem identified by the Examiner ever discussed or identified as being in need of a solution. Accordingly, *prima facie* obviousness has not been established.

Based upon the foregoing amendments and comments, Applicant the instant application is in condition for allowance. Questions regarding this application may be directed to the undersigned attorney by telephone, facsimile or electronic mail.

Respectfully submitted,

By 

John G. Posa

Reg. No. 37,424

Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, PC

PO Box 7021

Troy, MI 48007-7021

(734) 913-9300 FAX (734) 913-6007

Email: jposa@patlaw.com

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